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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/146,069	09/02/1998	TAKEHIRO YOSHIDA	1232-4467	6726

7590 02/12/2002

MORGAN & FINNEGAN
345 PARK AVENUE
NEW YORK, NY 10154

EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 02/12/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/146,069

Applicant(s)

YOSHIDA, TAKEHIRO

Examiner

Joseph R. Pokrzywa

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 January 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 31 January 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: Claims 1,2,5,9-11,20, and 22 raise new issues requiring further consideration.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-25.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

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DETAILED ACTION

Advisory Action

1. An appeal under 37 CFR 1.191 was filed in this application on 1/31/02. Appellant's brief is due on 3/31/02 in accordance with 37 CFR 1.192(a).

Response to Amendment

2. The amendment filed 1/31/02 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because:

- a. The proposed amendment raises new issues that would require further consideration and/or search.

Regarding *claims 1 and 9*, the addition of the limitation “notifying a recipient using a PSTN that a facsimile is being sent through the Internet, prior to the recipient accessing the Internet” raises new issues, not previously discussed in the claims, requiring further search and consideration.

Regarding *claims 2 and 10*, the addition of the limitation of “in response to a notification, from a calling party communication apparatus using a PSTN, that the calling party communication apparatus is sending a facsimile to the communication apparatus through the Internet” raises new issues, requiring further search and consideration.

Regarding *claims 5 and 11*, the addition of the limitation of “in response to a notification, from a calling party communication apparatus using a PSTN, that the calling party communication apparatus is sending a facsimile to the communication apparatus through the Internet, displaying information representing that the calling party communication apparatus is sending a facsimile to the communication apparatus through the Internet” raises new issues, requiring further search and consideration.

Regarding *claim 20*, the addition of the limitation of “means for transmitting facsimile data via the Internet, and ... means for notifying a recipient, by a method different from that of the transmission means, that the transmission means has executed transmission of the facsimile data via the Internet” raises new issues requiring further search and consideration.

Regarding *claim 22*, the addition of the limitation of “means for sending facsimile data over a first communication network to a recipient, means for sending data over a second communication network to said recipient, wherein the sending operation of the second means indicates that the first means has executed transmission of the facsimile data over the first communication network to said recipient” raises new issues requiring further search and consideration.

Response to Arguments

3. Applicant's arguments filed 1/31/02, with respect to unamended independent **claims 12, 18, and 19**, have been fully considered but they are not persuasive.

In response to applicant's argument regarding the rejection of **claims 12, 18, and 19**, stating on page 13 that Mordowitz fails to teach of notifying a calling party via the PSTN when a dial connection to the Internet is established, let alone notification related facsimile communication being sent over the Internet. The examiner notes that the claims currently do not include the limitation of "notifying a calling party via the PSTN", as argued, but rather "calling the station B from the station A, when the dial-up connection is established, using a general public network to transmit information representing that facsimile communication has been executed through the Internet and description information transmitted through the Internet". Further, Mordowitz teaches transmitting information representing that facsimile communication has been executed through the Internet, whereby when the dial-up connection to an Internet service provider is executed, as seen in step 82, and the receiving internet telephone accessory ITA 20 does not respond to the call setup signal, seen in step 96, the system notifies the ITA 20 using a general public network, being a POTS network, seen in step 98, by transmitting information, being the setup signal that includes the telephone number and the e-mail address, read in column 4, lines 27 through 31, representing that facsimile communication has been executed through the Internet, seen in Fig. 1, being the setup signal of step 94, which has been executed, and description information through the Internet, seen in Fig. 1, and being the setup signal that includes the telephone number and the e-mail address, read in column 4, lines 27 through 31. Because of this, the rejection of **claims 12, 18, and 19**, as cited in the final Office

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action dated 8/1/01, as being unpatentable over Mordowitz *et al.* in view of Bloomfield, is maintained.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

J. R. P.

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrj
February 11, 2002


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